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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/706,491 11/03/00 ROSS

G RI-69912/MAK

EXAMINER

IM52/0601

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ART UNIT	PAPER NUMBER

1762
DATE MAILED:

06/01/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/706,491

Applicant(s)

ROSS, GREGORY E.

Examiner

Michael Barr

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☒ Claim(s) 23-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The oath or declaration must state that the person signing acknowledges the duty to disclose to the Office all information known to the person to be material *to patentability as defined in 37 CFR 1.56, as required by 37 CFR 1.63(b)(3)*.

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. Claims 28-31 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claim 28 cites the limitation of applying a light absorbing coating over at least a portion of the second side of the base. This limitation is not described in the specification as originally filed and thus is considered to be new matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 28-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 28 cites the limitation of applying a light absorbing coating over at least a portion of the second side of the base. This limitation is not described in the specification as originally filed and thus is considered to be new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 47 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 cites the limitation of "at least one surface of said base is a surface at a different base-level on a different surface portion of said base". This limitation is very confusing to the examiner. What is this supposed to mean? Please explain.

Claim 47 cites the limitation of "at least a portion of said base is substantially three-dimensional". It is not clear to the examiner how an object in the "real" world could not be "substantially three-dimensional". It is not clear to the examiner how this limitation would define the base.

Claim 52 cites the limitation of a surface portion of the coating comprises "a second base". It is not clear whether or not this second base is the same as the second base of the independent claim, 51.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 23-27, 32-47, and 51-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshimura.

Yoshimura teaches a method of forming a multi-colored transfer sheet, where a base material, such as paper, is provided having an ink printable release coating on one side, multiple layers of ink printed colored coatings are applied to the base, the base is then punched through to provide the necessary picture, then the pattern of coatings is transferred to a glassware substrate, and then the picture is heated with UV lamp to fix or fuse the colored coatings to the substrate (Col. 1, lines 1-32; Col. 3, lines 7-48; Col. 7, lines 27-62; Figs. 1-2). The coating and punching of Yoshimura achieves substantial registration between the layers. The transfer step of Yoshimura would inherently use some amount of pressure, as the mere application of the pattern to the surface to which the pattern is transferred requires at least contact pressure for transfer. Yoshimura does not teach protecting the base and first coating. However, the application of the second coating layer of Yoshimura would have inherently provided some measure of protection for the base and first coating layer, and thus meets the claimed protection requirements. The article produced by Yoshimura meets the requirements of Claims 36-47 and 51-55.

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10. Claims 28-31 and 36-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill.

Hill teaches transferring a multi-colored design or decal to a transparent substrate, such as glass, using release paper, where the design or decal comprises ceramic ink (Col. 10, lines 2-49), such that the base is provided by applying a silhouette pattern to the paper, where the silhouette pattern can be formed by punching or drilling, and then layers of designs (printed ink) can be applied over the silhouette pattern, such that exact registration between the silhouette pattern and the design layers is achieved (Col. 17, lines 3-27; Col. 18, lines 18-22; Col. 19, lines 1-5). Figs. 18-25 of Hill shows that the design layers can be applied to more than one side of the silhouette pattern layer and thus meets the limitation of Claim 28 of applying a light absorbing coating over at least a portion of the second side of the base, as the design layers of Hill are at least partially light absorbing. The article produced by Hill meets the requirements of Claims 36-55.

Allowable Subject Matter

11. Claims 1-22 are allowed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cole et al. and Dressler are cited as prior art of interest.

Cole et al. teaches transferring a design to a ceramic substrate, using a transfer sheet, where the coating is enamel that contains metal particles and pigments.

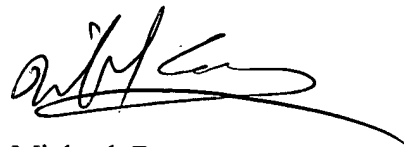
Dressler teaches a transfer sheet where the design is cut from the colored layers while on the release paper.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Michael Barr
Examiner
Art Unit 1762

MB
April 9, 2001



Shrive Beck
Supervisory Patent Examiner
Technology Center 1700